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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/538,493 | 03/30/2000 | Geoffrey B. Rhoads | 10512/0006/25SD | 8045 |
| 23735 | 7590 | 09/09/2004 | EXAMINER | |
| DIGIMARC CORPORATION 19801 SW 72ND AVENUE SUITE 250 TUALATIN, OR 97062 | | | SMITHERS, MATTHEW | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2137 | |

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|--------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/538,493 | RHOADS, GEOFFREY B. |
| | Examiner | Art Unit |
| | Matthew B Smithers | 2137 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 May 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-133 is/are pending in the application.
- 4a) Of the above claim(s) 1-10, 15, 17-19, 23-62 and 69-133 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 11-14, 16, 20-22 and 63-68 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/24/2004.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments, see amendment, filed May 18, 2004, with respect to the rejection(s) of claim(s) 11-14, 16, 20-22 and 63-68 under 112, first paragraph have been fully considered and are persuasive. As to the rejection under 112, first paragraph, the claims are considered fully supported as of the date of the filing of the application.

Accordingly, the applicant has been afforded the effective filing date of March 30, 2000.

Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of U.S. patent 5,889,868 granted to Moskowitz et al. Applicant's claim of priority prior to the effective filing date of the Moskowitz patent is not deemed sufficient according to section 2308.01 of the MPEP. The section states the applicant must file the items required under 37 CFR 1.608 (b) when claiming the same invention as a patent. For the applicant's benefit, the examiner is providing the applicable sections of 2308.01 for his consideration.

2308.01 Patent Has Filing Date Earlier Than Application

If the effective filing date of the application is more than 3 months after the effective filing date of the patent, 37 CFR 1.608(b) requires that the applicant must file (A) evidence, such as patents, publications and other documents, and one or more affidavits or declarations which demonstrate that applicant is *prima facie* entitled to a judgment relative to the patentee, and (B) an explanation stating with particularity the basis upon which the applicant is *prima facie* entitled to the judgment.

Art Unit: 2137

If an applicant is claiming the same invention as a patent which has an earlier effective United States filing date but there is not a statutory bar against the application, and the applicant has not submitted the items required by 37 CFR 1.608(a) or (b), as appropriate, the application should be rejected under 35 U.S.C. 102(e)/103. A statement should be included in the rejection that the patent cannot be overcome by an affidavit or declaration under 37 CFR 1.131 but only through interference proceedings. Note, however, 35 U.S.C. 135(b) and MPEP § 2307. The applicant should also be advised that an affidavit under 37 CFR 1.608(b) or evidence *and* an explanation under 37 CFR 1.608(b), as appropriate, must be submitted and it should be stated, if applicable, that the patentee has been accorded the benefit of an earlier U.S. application.

Based on the guidelines given in section 2308.01 of the MPEP, the examiner is applying the rejection below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 11-14, 16, 20-22 and 63-68 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. patent 5,889,868 granted to Moskowitz et al.

Regarding claim 11, Moskowitz meets the claimed limitations as follows:

"A method of encoding a watermark in a digital signal, comprising the steps of: generating varying watermark key bits; and encoding the watermark in the digital signal using the varying watermark key bits and characteristics of the digital signal." see column 2, lines 31-34; column 10, lines 30-56; and column 18, line 35 to column 19, line 21.

Regarding claim 12, Moskowitz meets the claimed limitations as follows:

"A method of encoding a watermark in a digital signal, comprising the steps of: generating varying watermark key bits; and encoding the watermark in the digital signal using the varying watermark key bits." see column 2, lines 31-34; column 10, lines 30-56; and column 18, line 35 to column 19, line 21.

Regarding claim 13, Moskowitz meets the claimed limitations as follows:

"A method of encoding a watermark in a digital signal, comprising the steps of: mapping key and processing state information to effect an encode/decode map; and encoding the watermark in the digital signal using the encode/decode map and characteristics of the digital signal." see column 3, lines 39-44 and column 10, lines 30-62.

Regarding claim 14, Moskowitz meets the claimed limitations as follows:

"A method of encoding a watermark in a digital signal, comprising the steps of: mapping key and processing state information to effect an encode/decode map; and encoding the watermark in the digital signal using the encode/decode map and characteristics of the digital signal." see column 3, lines 39-44 and column 10, lines 30-62.

Regarding claim 16, Moskowitz meets the claimed limitations as follows:
"A method of generating a noise signal to produce watermark information, wherein the noise signal is a function of at least one variable which depends on key and processing state information." see column 3, lines 50-54.

Regarding claim 20, Moskowitz meets the claimed limitations as follows:
"A method of encoding watermarks in a signal using a spread spectrum technique to encode where the encoding method is pseudo-random." see column 2, lines 31-34; column 10, lines 30-56; and column 18, line 35 to column 19, line 21.

Regarding claim 21, Moskowitz meets the claimed limitations as follows:
"A method of decoding watermarks in a signal using a spread spectrum technique to decode where the decoding method is pseudo-random." see column 2, lines 31-34; column 10, lines 30-56; and column 18, line 35 to column 19, line 21.

Regarding claim 22, Moskowitz meets the claimed limitations as follows:
"The method of claim 21, wherein the information is encoded and the encoding method is pseudo-random." see column 5, lines 59-66.

Regarding claim 63, Moskowitz meets the claimed limitations as follows:
"A system for encoding a watermark in a digital signal, comprising:

Art Unit: 2137

a generator for generating a plurality of watermark pseudo-random key bits; and an encoder for encoding the watermark in the digital signal using the watermark pseudo-random key bits and characteristics of the digital signal." see column 2, lines 31-34; column 10, lines 30-56; and column 18, line 35 to column 19, line 21.

Regarding claim 64, Moskowitz meets the claimed limitations as follows:

"The system of claim 63, wherein the generator is selected from the group consisting of a non-linear generator and a scrambling generator." see column 10, lines 39-42.

Regarding claim 65, Moskowitz meets the claimed limitations as follows:

"The system of claim 63, wherein the characteristics of the digital signal comprise mathematically defined functions of the digital signal." see column 18, line 62 to column 19, line 2.

Regarding claim 66, Moskowitz meets the claimed limitations as follows:

"A system for encoding a watermark in a digital signal, comprising:
a mapper for mapping a pseudo-random key and processing state information to effect an encode/decode map using a generator; and an encoder for encoding the watermark in the digital signal using the encode/decode map and characteristics of the digital signal." see column 2, lines 31-34; column 10, lines 30-56; and column 18, line 35 to column 19, line 21.

Regarding claim 67, Moskowitz meets the claimed limitations as follows:

"The system of claim 66, wherein the generator is selected from the group consisting of a non-linear generator and a scrambling generator." see column 10, lines 39-42.

Regarding claim 68, Moskowitz meets the claimed limitations as follows:

"The system of claim 66, wherein the characteristics of the digital signal comprise mathematically defined functions of the digital signal." see column 18, line 62 to column 19, line 2.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew B Smithers whose telephone number is (703) 308-9293. The examiner can normally be reached on Monday-Friday (9:00-5:30) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew T Caldwell can be reached on (703) 306-3036. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Matthew B. Smithers
Primary Examiner
Art Unit 2137